

identifying mutations. This is believed to be a typographical error, since these claims do not include this limitation. As explained below, all of the above elections are made with traverse.

In the present case, applicants particularly traverse the restriction between Groups II and III. According to the MPEP, where claims can be examined together without undue burden, the Examiner *must* examine the claims on the merits even though they are directed to independent and distinct inventions. *See*, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner *must* show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner *must* show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02).

In the present restriction, Groups II and III are indicated as both classified under Class 435, subclass 6. The Examiner has provided little or no reasoning to show that the two groups meet the other two criteria required under §808.02. Instead, the Examiner simply states that the claimed methods differ in the objectives, method steps, and the like. Moreover, in the parent application (USSN 08/785,532) the Examiner has already issued a substantive Office Action (mailed September 9, 1997) directed to these two inventions. At a minimum, this means that the Examiner has performed searches relevant to these two groups. Thus, the burdens imposed by the examination of the two groups have already been encountered and are presumed not to be undue.

In addition, applicants note that claim 26 has been placed in Groups I and II. The courts have long held that an Examiner may not reject a particular claim on the basis that it represents "independent and distinct" inventions. *See, In Re Weber, Soder and Boksay* 198 USPQ 328, 331 (C.C.P.A. 1978). *See also, In Re Haas* 179 USPQ 623, 624, 625 (*In Re*

Haas I (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

The courts have definitively ruled that the section of the patent statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. See, *In Re Weber, Soder and Boksay*, *In Re Haas I* and *In Re Haas II*. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, *In Re Weber, Soder and Boksay* at 334.

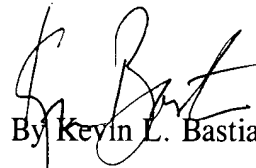
In conclusion, Applicants respectfully submit that in light of the conclusory statements used to support the restriction and the fact that searches must have already been carried out, the Examiner has not provided sufficient reasoning to establish undue burden of examining Groups II and III in a single application. Moreover, there is no statutory authority for imposing a restriction requirement on a single claim, as was done here. The courts have expressly held that the type of restriction requirement made by the Examiner is improper. Withdrawal of the restriction is respectfully requested.

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If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 576-0200.

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